

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed February 22, 2006. Upon entry of the amendments in this response, claims 1 – 25 and 27 – 36 remain pending. In particular, Applicants amend claims 1, 2, 4, 8 – 16, 19, 21 – 22, 27 – 33, and 36. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Rejections Under 35 U.S.C. §103

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the cited art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, “[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

A. Claim 1 is Patentable Over *Ellis*

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/60790, (hereinafter “*Ellis*”). Applicants respectfully traverse this rejection for at least the reason that *Ellis* fails to disclose, teach, or suggest all of the elements of claim 1. More specifically, claim 1, as amended, recites:

A method for providing media services via an interactive media services client device coupled to a programmable media services server device, said method comprising:

providing a user with an interactive program guide (IPG), the IPG including a television program schedule, the television program schedule including at least one currently scheduled television program, said currently scheduled television program being scheduled for broadcast to a plurality of users at a predetermined current time, and at least one scheduled future television program, said scheduled future television program being otherwise available only via a scheduled broadcast to a plurality of users at a predetermined later time;

providing said user with an option to view the scheduled future television program at a user-defined time;

receiving user input requesting said scheduled future television program for display at a user-defined time, wherein said user-defined time is prior to said later time, and wherein said user input requesting said scheduled future television program for display at a user-defined time includes a request for ***beginning a display of the scheduled future television program at a time when said scheduled future television program is not scheduled to begin broadcasting to a plurality of users;*** and

providing said user with said scheduled future television program at said user-defined time. (emphasis added)

The Office Action first asserts:

Ellis Figure 8, discloses the *Truman Show* offered immediately in November of 1999 (PCT Publication date). A user is allowed to set a time for when he or she would like to view the Truman Show, but, it is not clear whether *The Truman Show* is “otherwise available only” via a later broadcast. However, the cited NPL reference (*i.e.*, thestranger.com reference) shows the Truman Show being publicly available on NBC in February of 2001. These references taken in combination teach an IPG displaying a figure television program (*i.e.*, The Truman Show), said future television program scheduled to be broadcast at a later time (*i.e.*, on NBC in 2001), whereby the user is allowed to receive the program in advance of the later scheduled time. (OA p. 3, line 1)

Applicants respectfully disagree with this analysis. More specifically, Applicants submit that *Ellis* discloses a “Program Guide System with Video-On-Demand Browsing” (title). “If a video-on-demand program of interest is found, the viewer has several options. For example, the

viewer may... 2) request the program...” (p. 25, line 10). [I]f the selected program is ordered for a later time, the program guide may automatically start the program at that later time.

Furthermore, the program guide may be configured to present a reminder screen... so that the viewer is reminded of the scheduled start-time. When this reminder is received, the viewer may be given the option to... watch the program immediately...” (p 25, line 30).

Applicants respectfully submit that the cited art fails to disclose, teach, or suggest “providing a user with an interactive program guide (IPG), the IPG including... at least one scheduled future television program, said scheduled future television program being otherwise available only via a scheduled broadcast to a plurality of users at a predetermined later time [and] *providing said user with an option to view the scheduled future television program at a user-defined time*” as recited in claim 1, as amended.

Further, the *www.stranger.com* reference merely discloses a television listing for *The Truman Show*. Applicants respectfully submit that the *www.stranger.com* reference fails to overcome the deficiencies of *Ellis*. For at least this reason Applicants submit that claim 1, as amended, is allowable over the cited art.

Additionally, the Office Action asserts that in *Ellis* “[a] user is allowed to request said future program prior to its later scheduled broadcast time... [b]ut *Ellis* fails to teach whether the requested program is ‘otherwise available only via a scheduled broadcast to a plurality of users at a predetermined later time.’ However, it is well known in this art for newly released programs to be available on VOD, pay-per-view, or any other similar system before they are available on non-pay television...” (OA p. 2, line 11).

Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the

specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required. Additionally, Applicants submit that merely providing a reference (or a couple of references) that allegedly discloses the subject matter in question, does not rise to an evidentiary level of being well known in the industry. Applicants submit that even if the cited references disclose the subject matter in question (a point that the Applicants are not conceding), presence of that subject matter in a reference does not raise the level of commonality of that subject matter to something of unquestionable fact. For at least this specific and particular reason, Applicants submit that the subject matter in question is not well known in the art.

Applicants additionally submit that particularly in the context of the claimed combination that includes “*providing said user with an option to view the scheduled future television program at a user-defined time*,” the subject matter is too complex for a reasonably skilled person to be considered well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject matter in question is not well known in the art, respectfully traverse the cited well known subject matter, and submit that claim 1, as amended is patentable in view of the cited art.

In addition, the Office Action asserts “[f]urthermore, when taken in combination, it is inherent that the user would not otherwise receive the program in advance of its 2001 NBC date, unless he or she requested in advance” (OA p. 13, line 11). Applicants respectfully traverse the finding of inherency. It is well established that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain

thing may result from a given set of circumstances is not sufficient.” *In Re Anthony J. Robertson*, 98-1270 (Fed. Cir. 1999).

Applicants assert that the subject matter of claim 1 is not well known and expected in the art. In accordance with *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999), Applicants traverse the inherency finding and assert that claim 1, as amended, is allowable over the cited art.

B. Claim 19 is Patentable Over *Ellis*

The Office Action indicates that claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/60790, (hereinafter “*Ellis*”). Applicants respectfully traverse this rejection for at least the reason that *Ellis* fails to disclose, teach, or suggest all of the elements of claim 19. More specifically, claim 19, as amended, recites:

A media services device for providing a client device with a media presentation, said device comprising:

logic configured to receive from a cable television system (CTS) a television program schedule, said television program schedule including at least one currently scheduled television program, said currently scheduled television program being scheduled for broadcast to a plurality of users at a predetermined current time, said television program schedule including at least one scheduled future television program, said scheduled future television program being otherwise available only via a scheduled broadcast to a plurality of users at a predetermined later time;

logic configured to provide said client device with information related to an interactive program guide (IPG) that includes said television program schedule;

logic configured to provide said client device with data related to a user option to provide said client device with said scheduled future television program at a user-defined time; and

logic configured to provide said client device with said scheduled future television program at a user-defined time according to a received user input,

wherein said user-defined time is prior to said later time, and

wherein said received user input can include a request for beginning a display of the scheduled future television program at a time when said scheduled future television program is not scheduled to begin broadcasting to a plurality of users. (*emphasis added*)

The Office Action first asserts:

Ellis Figure 8, discloses the *Truman Show* offered immediately in November of 1999 (PCT Publication date). A user is allowed to set a time for when he or she would like to view the Truman Show, but, it is not clear whether *The Truman Show* is “otherwise available only” via a later broadcast. However, the cited NPL reference (*i.e.*, thestranger.com reference) shows the Truman Show being publicly available on NBC in February of 2001. These references taken in combination teach an IPG displaying a figure television program (*i.e.*, The Truman Show), said future television program scheduled to be broadcast at a later time (*i.e.*, on NBC in 2001), whereby the user is allowed to receive the program in advance of the later scheduled time. (OA p. 3, line 1)

Applicants respectfully disagree with this analysis. More specifically, Applicants submit that *Ellis* discloses a “Program Guide System with Video-On-Demand Browsing” (title). “If a video-on-demand program of interest is found, the viewer has several options. For example, the viewer may... 2) request the program...” (p. 25, line 10). [I]f the selected program is ordered for a later time, the program guide may automatically start the program at that later time. Furthermore, the program guide may be configured to present a reminder screen... so that the viewer is reminded of the scheduled start-time. When this reminder is received, the viewer may be given the option to... watch the program immediatcly...” (p 25, line 30).

Applicants respectfully submit that the cited art fails to disclose, teach, or suggest “media services device for providing a client device with a media presentation, said device comprising... television program schedule including at least one scheduled future television program, said scheduled future television program being otherwise available only via a

scheduled broadcast to a plurality of users at a predetermined later time [and] ***logic configured to provide said client device with said scheduled future television program at a user-defined time according to a received user input***” as recited in claim 19, as amended.

Further, the *www.stranger.com* reference merely discloses a television listing for *The Truman Show*. Applicants respectfully submit that the *www.stranger.com* reference fails to overcome the deficiencies of *Ellis*. For at least this reason Applicants submit that claim 19, as amended, is allowable over the cited art.

Additionally, the Office Action asserts that in *Ellis* “[a] user is allowed to request said future program prior to its later scheduled broadcast time... [b]ut *Ellis* fails to teach whether the requested program is ‘otherwise available only via a scheduled broadcast to a plurality of users at a predetermined later time.’ However, it is well known in this art for newly released programs to be available on VOD, pay-per-view, or any other similar system before they are available on non-pay television...” (OA p. 2, line 11).

Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required. Additionally, Applicants submit that merely providing a reference (or a couple of references) that allegedly discloses the subject matter in question, does not rise to an evidentiary level of being well known in the industry. Applicants submit that even if the cited references disclose the subject matter in question (a point that the Applicants are not conceding), presence of that subject matter in a reference does not raise the level of commonality of that subject matter to something

of unquestionable fact. For at least this specific and particular reason, Applicants submit that the subject matter in question is not well known in the art.

Applicants additionally submit that particularly in the context of the claimed combination that includes “*logic configured to provide said client device with said scheduled future television program at a user-defined time according to a received user input,*” the subject matter is too complex for a reasonably skilled person to be considered well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject matter in question is not well known in the art, respectfully traverse the cited well known subject matter, and submit that claim 19, as amended is patentable in view of the cited art.

In addition, the Office Action asserts “[f]urthermore, when taken in combination, it is inherent that the user would not otherwise receive the program in advance of its 2001 NBC date, unless he or she requested in advance” (OA p. 13, line 11). Applicants respectfully traverse the finding of inherency. It is well established that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In Re Anthony J. Robertson*, 98-1270 (Fed. Cir. 1999).

Applicants assert that the subject matter of claim 19 is not well known and expected in the art. In accordance with *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999), Applicants traverse the inherency finding and assert that claim 19, as amended, is allowable over the cited art.

C. Claim 36 is Patentable Over *Ellis*

The Office Action indicates that claim 36 stands rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/60790, (hereinafter "*Ellis*"). Applicants respectfully traverse this rejection for at least the reason that *Ellis* fails to disclose, teach, or suggest all of the elements of claim 36. More specifically, claim 36, as amended, recites:

A media services client device for providing a user with a media presentation, said device comprising:

logic configured to receive from a cable television system (CTS) a television program schedule, said television program schedule including at least one currently scheduled television program, said currently scheduled television program being scheduled for broadcast to a plurality of users at a predetermined current time, and at least one scheduled future television program, said scheduled future television program being otherwise available only via a scheduled broadcast to a plurality of users at a predetermined later time;

logic configured to provide said user with an interactive program guide (IPG) configured to display the television program schedule; and

logic configured to provide said user with said scheduled future television program at a user-defined time,

wherein said user-defined time is prior to said later time, and

wherein said logic configured to provide said user with said scheduled future television program at a user-defined time includes logic configured to begin presentation of said scheduled future television program at a time when said scheduled future television program is not scheduled to begin broadcasting to a plurality of users. (***emphasis added***)

The Office Action first asserts:

Ellis Figure 8, discloses the *Truman Show* offered immediately in November of 1999 (PCT Publication date). A user is allowed to set a time for when he or she would like to view the Truman Show, but, it is not clear whether *The Truman Show* is "otherwise available only" via a later broadcast. However, the cited NPL reference (*i.e.*, thestranger.com reference) shows the Truman Show being publicly available on NBC in February of 2001. These references taken in combination teach an IPG displaying a figure television program (*i.e.*, The Truman Show), said future television program scheduled to be broadcast at a later time (*i.e.*, on

NBC in 2001), whereby the user is allowed to receive the program in advance of the later scheduled time. (OA p. 3, line 1)

Applicants respectfully disagree with this analysis. More specifically, Applicants submit that *Ellis* discloses a “Program Guide System with Video-On-Demand Browsing” (title). “If a video-on-demand program of interest is found, the viewer has several options. For example, the viewer may... 2) request the program...” (p. 25, line 10). [I]f the selected program is ordered for a later time, the program guide may automatically start the program at that later time. Furthermore, the program guide may be configured to present a reminder screen... so that the viewer is reminded of the scheduled start-time. When this reminder is received, the viewer may be given the option to... watch the program immediately...” (p 25, line 30).

Applicants respectfully submit that the cited art fails to disclose, teach, or suggest “media services client device for providing a user with a media presentation, said device comprising... logic configured to receive from a cable television system (CTS) a television program schedule, said television program schedule including... at least one scheduled future television program, said scheduled future television program being otherwise available only via a scheduled broadcast to a plurality of users at a predetermined later time [and] ***logic configured to provide said user with said scheduled future television program at a user-defined time***” as recited in claim 36, as amended.

Further, the *www.stranger.com* reference merely discloses a television listing for *The Truman Show*. Applicants respectfully submit that the *www.stranger.com* reference fails to overcome the deficiencies of *Ellis*. For at least this reason Applicants submit that claim 36, as amended, is allowable over the cited art.

Additionally, the Office Action asserts that in *Ellis* “[a] user is allowed to request said future program prior to its later scheduled broadcast time... [b]ut *Ellis* fails to teach whether the requested program is ‘otherwise available only via a scheduled broadcast to a plurality of users at a predetermined later time.’ However, it is well known in this art for newly released programs to be available on VOD, pay-per-view, or any other similar system before they are available on non-pay television...” (OA p. 2, line 11).

Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required. Additionally, Applicants submit that merely providing a reference (or a couple of references) that allegedly discloses the subject matter in question, does not rise to an evidentiary level of being well known in the industry. Applicants submit that even if the cited references disclose the subject matter in question (a point that the Applicants are not conceding), presence of that subject matter in a reference does not raise the level of commonality of that subject matter to something of unquestionable fact. For at least this specific and particular reason, Applicants submit that the subject matter in question is not well known in the art.

Applicants additionally submit that particularly in the context of the claimed combination that includes “***logic configured to provide said user with said scheduled future television program at a user-defined time,***” the subject matter is too complex for a reasonably skilled person to be considered well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject

matter in question is not well known in the art, respectfully traverse the cited well known subject matter, and submit that claim 36, as amended is patentable in view of the cited art.

In addition, the Office Action asserts “[f]urthermore, when taken in combination, it is inherent that the user would not otherwise receive the program in advance of its 2001 NBC date, unless he or she requested in advance” (OA p. 13, line 11). Applicants respectfully traverse the finding of inherency. It is well established that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In Re Anthony J. Robertson*, 98-1270 (Fed. Cir. 1999).

Applicants assert that the subject matter of claim 36 is not well known and expected in the art. In accordance with *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999), Applicants traverse the inherency finding and assert that claim 36, as amended, is allowable over the cited art.

D. Claims 3 – 4, 7 – 8, 10 – 12, and 18 are Patentable Over *Ellis*

The Office Action indicates that claims 3 – 4, 7 – 8, 10 – 12, and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis*. Applicants respectfully traverse this rejection for at least the reason that *Ellis* fails to disclose, teach, or suggest all of the elements of claims 3 – 4, 7 – 8, 10 – 12, and 18. More specifically, dependent claims 3 – 4, 7 – 8, 10 – 12, and 18 are believed to be allowable for at least the reason that these claims depend from allowable

independent claim 1. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

E. Claims 20 – 21, 25, 28 – 29, and 35 are Patentable Over *Ellis*

The Office Action indicates that claims 20 – 21, 25, 28 – 29, and 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis*. Applicants respectfully traverse this rejection for at least the reason that *Ellis* fails to disclose, teach, or suggest all of the elements of claims 20 – 21, 25, 28 – 29, and 35. More specifically, dependent claims 20 – 21, 25, 28 – 29, and 35 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 19. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

F. Claims 2 and 22 is Patentable Over *Ellis* in view of *Kostreski*

The Office Action indicates that claims 2 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of U.S. Patent No. 5,534,912 (hereinafter “*Kostreski*”). Applicants respectfully traverse this rejection for at least the reason that *Ellis* in view of *Kostreski* fails to disclose, teach, or suggest all of the elements of claims 2 and 22. More specifically, dependent claim 2 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 1. Dependent claim 22 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 19. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

G. Claims 5 – 6 and 23 – 24 are Patentable Over *Ellis* in view of *Matthews*

The Office Action indicates that claims 5 – 6 and 23 – 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of U.S. Patent No. 5,815,145 (hereinafter “*Matthews*”). Applicants respectfully traverse this rejection for at least the reason that *Ellis* in view of *Matthews* fails to disclose, teach, or suggest all of the elements of claims 5 – 6 and 23 – 24. More specifically, dependent claims 5 – 6 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Dependent claims 23 – 24 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 19. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

H. Claims 9, 15 – 17, 27, and 32 – 34 are Patentable Over *Ellis* in view of *Girard et al.*

The Office Action indicates that claims 9, 15 – 17, 27, and 32 – 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of U.S. Patent No. 5,751,282 (hereinafter “*Girard*”). Applicants respectfully traverse this rejection for at least the reason that *Ellis* in view of *Girard* fails to disclose, teach, or suggest all of the elements of 9, 15 – 17, 27, and 32 – 34. More specifically, dependent claims 9 and 15 – 17 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Dependent claims 27 and 32 – 34 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 19. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

I. Claims 13 – 14 and 30 – 31 are Patentable Over *Ellis* in view of *Gordon et al.*

The Office Action indicates that claims 13 – 14 and 30 – 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of U.S. Patent No. 5,682,597 (hereinafter “*Gordon*”). Applicants respectfully traverse this rejection for at least the reason that *Ellis* in view of *Gordon* fails to disclose, teach, or suggest all of the elements of claims 13 – 14 and 30 – 31. More specifically, dependent claims 13 – 14 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Dependent claims 30 – 31 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 19. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

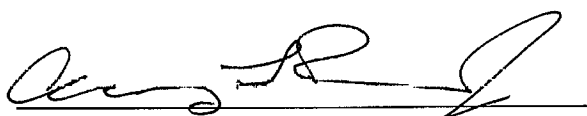
CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Further, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


Anthony F. Bonner, Reg. No. 55,012

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500